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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,323	01/28/2004	Timothy Dumin	30004.01	5474

7590

11/22/2005

The Law Office of Steven G. Roeder  
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La Jolla, CA 92037

EXAMINER

PASSANITI, SEBASTIANO

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 11/22/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Tain

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/767,323	DURNIN, TIMOTHY	
	<b>Examiner</b>	<b>Art Unit</b>	
	Sebastiano Passaniti	3711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on see detailed Office action.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6,9-19,21-29,31-44,46-56 and 58-60 is/are rejected.
- 7) ☒ Claim(s) 7,8,20,30,45 and 57 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/28/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This Office action is responsive to communication received 09/12/2005 – Election and Amendment.

#### ***Response to Amendment***

Applicant's election with traverse of Group I, Species II in the reply filed on 09/12/2005 is acknowledged. The traversal is on the ground(s) that the claims (as amended) should no longer be the subject of a restriction requirement as the claims of the Group II method closely parallel corresponding claims of the Group I product. Moreover, applicant's election of Species II is followed with an argument that all the claims read on Species II.

This argument has been found persuasive and the restriction requirement based upon the claims (as amended) has been withdrawn for the time being. Applicant is respectfully urged to maintain a distinct line among the species outlined in the restriction requirement so that future amendments to the claims reflect limitations relating only to Species II.

Moreover, while a formal rejection under undue multiplicity is not being drafted at this time, applicant is respectfully urged to further limit the number of claims drawn to Species II, as it would appear that an unreasonable amount of claims directed to one embodiment are currently present in this application. Future amendments to the outstanding number of claims may result in clouding or confusing the pertinent issues in this application, which may be reason enough to raise the question of multiplicity of claims at some point in the future.

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Claims 1-60 remain pending.

Following is an action on the MERITS:

***Claim Rejections - 35 USC § 102 and 103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

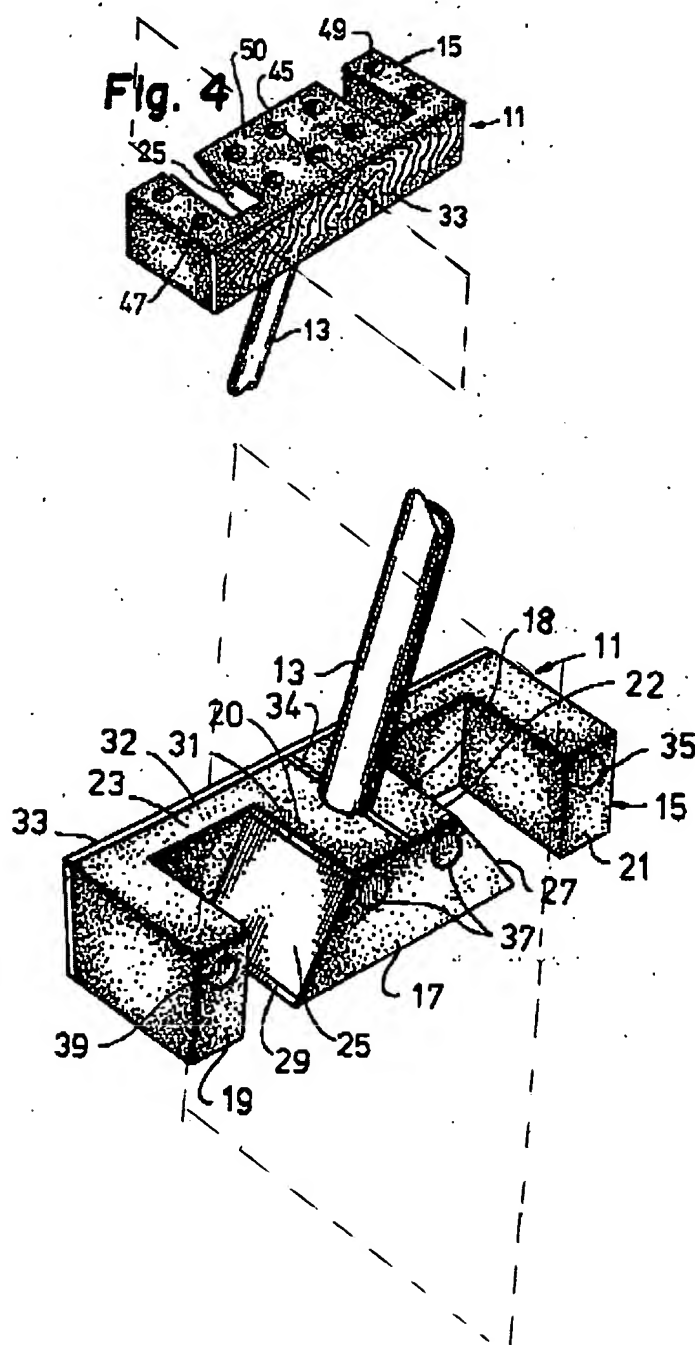
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 10, 12, 23, 24, 25, 29, 33, 34, 35, 38, 41, 42, 43, 44, 47, 48, 53, 55, 56, 58 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Rudell ('184).

As to claim 1, Figures 1 and 4, as highlighted below, show that the putter body (15) includes a centrally positioned transition plane that may be used to demarcate the body into a heel region and a toe region. Rudell further includes a heel weight in the heel region and a toe weight in the toe region. A sole insert is provided. Each of the body, heel weight, toe weight and sole insert include a material having a specific gravity, with the specific gravity of the heel and toe weights and the sole insert being greater than the specific gravity of the body. Here, the body is primarily made of, for example,

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aluminum with a wooden face, while the heel and toe weights and sole inserts are made of lead (col. 2, lines 30-34 and col. 5, line 48 through col. 6, line 6).



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As to claim 2, Figure 4 clearly shows that the first sole insert is positioned partly in the heel and toe regions.

As to claim 3, the heel and toe weight are similar in weight, as the cavities housing the heel and toe weights are similar.

As to claim 4, the sole includes a sole surface within which the first sole cavity is located.

As to claim 5, the specific gravity of the heel weight (second specific gravity) and toe weight (third specific gravity) as well as the specific gravity of the sole insert (fourth specific gravity) are substantially similar, as lead is preferably used for all the elements.

As to claim 10, the sole includes at least a second sole insert.

As to claim 12, one of the sole inserts is clearly positioned in one of either the heel or toe regions.

As to claim 23, the putter body clearly includes a sole region having first and second sole cavities, with each cavity including an insert therein, and with each cavity being positioned partly in the heel and toe region.

As to claim 24, the sole defines the perimeters of the first and second cavities, as broadly as claimed.

As to claim 25, the specific gravity of the material of the sole insert is greater than the specific gravity of the material of the body, since the sole inserts may be formed of lead and the body may be formed of aluminum.

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As to claim 29, heel weight (35) along with toe weight (39) the sole insert (adjacent numeral 45) intersecting the transition plane and located furthest from the plane of the face collectively may be considered to form a triangle, as broadly as claimed.

As to claim 33, the insert is substantially flush with the exterior of the sole surface.

As to claim 34, the sole insert is indeed positioned symmetrically with respect to the transition plane, as the transition plane intersects the sole inserts, as shown in the highlighted version of Figure 4, *supra*.

As to claim 35, both sole inserts are positioned symmetrically with respect to the transition plane.

As to claim 38, here again, the putter body includes a first and second sole insert.

As to claim 41, see the remarks for claim 25, *supra*.

As to claim 42, see the remarks for claim 32, *supra*.

As to claim 43, see the remarks for claim 1, *supra*.

As to claim 44, see the remarks for claim 29, *supra*.

As to claim 47, see the remarks for claim 32, *supra*.

As to claim 48, see the remarks for claim 34, *supra*.

As to claim 53, see the remarks for claim 38, *supra*. The method steps very closely parallel the limitations of the product claims. The product claims thereby inherently include the method of manufacturing the putter head.

As to claim 55, see the remarks for claims 34 and 35, *supra*.

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As to claim 56, see the remarks for claim 29, *supra*.

As to claim 58, Rudell includes a first and second sole insert with a portion of each insert located within the heel and toe regions.

As to claim 60, see the remarks for claim 29, *supra*.

Claims 9, 11, 13, 14, 26, 27, 28, 31, 32, 39, 40, 46, 51, 54 and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rudell. At the outset, it is noted that Rudell is concerned generally with providing a putter-type club head body with a means for selectively altering the weight distribution by incorporating a plurality of recesses or cavities into which weights or inserts may be positioned in any one or all of a heel region, toe region and sole region. Rudell acknowledges that the weights and inserts are preferably formed of lead, but that many other materials are suitable for weighting the head (col. 5, line 63 through col. 6, line 6).

As to claims 9, 13, 14, 26, 27, 28, 31, 39, 40, 54 and 59, although the specific claimed limitations of the specific gravity are not detailed by Rudell, one of ordinary skill in the art would have found it obvious to modify the device in the cited art reference to Rudell by incorporating a suitable material in each of the heel region, toe region and sole region, the motivation being to provide a weight distribution that is desirable to an individual golfer, but that nonetheless still fulfills the requirements for the overall weight of the head (col. 6, lines 61-65 in Rudell).

Specific to claims 11, 26 and 51, Rudell does acknowledge that, based upon the type of weighting material used, selective cavities in the head may remain partially filled.



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See col. 5, line 65 through col. 6, line 3. Hence, one of ordinary skill in the art would have found it obvious to simply size the cavities in the sole region such that the material inserted within one cavity is sized volumetrically different from another cavity in the sole, the motivation again being to simply provide a specific weight distribution.

As to claim 32, the second sole insert may be defined as being further to the face region than the first sole insert.

Claims 1, 10, 15, 38 and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by MacIntyre ('349).

As to claims 1 and 38, reference is made to Figures 1, 5 and 7, showing a demarcation of the putter body along a plane that intersects alignment indicia (20), with the putter body further including a heel region, toe region and a sole region, whereby the sole region includes at least a first sole insert.

As to claim 10, the sole includes at least a second sole insert.

As to claims 15 and 52, Figure 8 shows the wedge-shape of the inserts that may be provided within the sole.

Claims 1, 16, 21, 23, 36, 38 and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Stuff ('874).

As to claims 1, 23 and 28, reference is made to Figures 1, 2 and 7, wherein Stuff shows a demarcation of the putter body along a plane that includes the centerline (CL).

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Stuff further includes a heel region, toe region and sole region. Each region includes an insert or weight (26).

As to claims 16, 36 and 49, note sighting device (16) fashioned within an upper cavity of the body. This upper cavity (Figure 5) appears to face generally opposite the direction of the sole insert and clearly is configured with a circular shape. Further, the disc-shaped alignment assembly is fashioned of plastic material and is thus less than the specific gravity of the first material, i.e., less than the specific gravity of the material from which the body is constructed.

As to claim 21, here again, the disc-shaped alignment assembly is fashioned of plastic material and is thus less than the specific gravity of the first material, i.e., less than the specific gravity of the material from which the body is constructed.

Claims 17, 18, 19, 37 and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stuff.

As to claims 17, 37 and 50, although Stuff does not provide a specific dimension for the upper region insert, the skilled artisan would have found it obvious to design the insert with a suitable dimension so that the alignment device may be easily viewed by a golfer.

As to claims 18 and 19, note the incorporated alignment guides in Stuff (Figures 5, 6 and 7).

Claims 1 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 2001-137400. See Figures 7 and 8 showing heel and toe regions, with each region including an insert and further wherein the heel region includes said insert at the face, whereby the heel insert is flush with the exterior surface of the face.

### ***Claim Objections***

Claims 21, 37 and 54 are objected to because of the following informalities:

As to claim 21, what happened to the fifth and sixth specific gravities?

As to claim 37, this claim depends on subsequent claim 38. Claims should depend on a previous claim, though it is understood that the numbering of claims may change throughout prosecution.

As to claim 54, both lines 1 and 2 reference "second specific gravity".

Appropriate correction is required.

### ***Allowable Subject Matter***

Claims 7, 8, 20, 30, 45 and 57 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Detailed reasons for allowance will be provided if and when this application is in condition for allowance.

### ***Further references of record***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Note heel weight (5) in Innes. See Figures 3 and 7 in Smith. Tseng shows cavities in the sole, of interest. See Figure 2 in Solari. Grace ('625)

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shows a putter weighting arrangement, of interest. Note Figure 1 in JP 599055740.  
(2001-224717).


### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sebastiano Passaniti whose telephone number is 571-272-4413. The examiner can normally be reached on Monday through Friday (6:30AM - 3:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene L. Kim can be reached on 571-272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.Passaniti/sp  
November 18, 2005

  
Sebastiano Passaniti  
Primary Examiner